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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,083	08/29/2000	Takehiro Tsutsumi	196727US0	9188

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 01/22/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/650,083

Applicant(s)

TSUTSUMI ET AL.

Examiner

Dr. Kelechi C. Egwim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of species a), claim 5 in Paper No. 11 is acknowledged. The traversal is on the ground(s) that claim 5 merely further defines what is meant by aliphatic hydrocarbon groups having 2 to 6 carbon atoms. This is not found persuasive because claim 5 requires that R¹ and R³ be selected from acyclic aliphatic hydrocarbons and claim 6 requires that they be selected from alicyclic groups, i.e., cyclic aliphatic groups.

Since these species are not art recognized equivalents, the requirement is still deemed proper and is therefore made FINAL.

2. This application contains claim 6 drawn to an invention nonelected with traverse in Paper No. 11. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

3. Due to persuasive arguments by applicant, the previous rejections of record based on Tomita et al. have been overcome and are hereby withdrawn.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-4 and 7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. While the originally filed description provides support for an ink wherein R¹ and R³ in the formulas (I-IV) may be a group selected from ethyl, propyls, butyls, hexyl and isohexyl, the originally filed description does not disclose that R¹ and R³ may be limited to **any** "monovalent aliphatic hydrocarbon group having 2 to 6 carbon atoms." There is no positive recitation of R¹ and R³ in the formulas (I-IV) being "monovalent aliphatic **hydrocarbon** group[s]". Pentyl, for instance, which is not taught in the originally filed description as representative of R¹ and R³ (see page 10, line 25 to page 11, line 5) would be **imported as new matter** into the claimed R¹ and R³ groups with the use of the term "monovalent aliphatic hydrocarbon group having 2 to 6 carbon atoms".

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Fague, for reasons cited in the previous action

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8. Claims 1-3 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Kappele et al., for reasons cited in the previous action.

9. Claims 1-3, 5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Hattori, for reasons cited in the previous action.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 4 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Kappele et al. or Hattori, for reasons cited in the previous action.

Response to Arguments

12. Applicant's arguments filed 8/29/02 have been fully considered but they are not persuasive.

13. Regarding the argument that the references teach pigment particles disperse in a water-based ink verses applicant's polymer particles, containing colorant, dispersed in a

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water-based ink, the prior art pigment particles **are** pigments/organic dyes dispersed in a polymer resin, wherein the resin containing the colorant (i.e., the organic pigment particles) is dispersed in the water-based ink. See Fague (col. 4, lines 55-67), Kappel et al. col. 2, lines 54-59) and Hattori (end of ¶ 4—see enclosed translation)

14. Regarding the low molecular weight polyethylene oxide derivates, as stated above, applicant's originally filed description does not provide sufficient support for claims to an ink wherein R^1 and R^3 are limited to "monovalent aliphatic **hydrocarbon**[s] group having 2 to 6 carbon atoms." The prior art requirements for the rejection of claims to the originally filed ink R^1 and R^3 are met. Also applicant should see ¶ 5 of Hattori.

15. Regarding claim 4, as previously stated, the prior art teaches the present water based ink compositions. While Kappel et al. or Hattori do not expressly teach the surface tension of the polyoxyalkylene oxide derivatives as claimed, it is still reasonable that the surface tension of the prior art polyoxyalkylene oxide derivatives would be the same as that in the presently claimed composition, since the compositions and polyoxyalkylene oxide derivatives of Kappel et al. or Hattori are essentially the same as that presently claimed. In any event, the USPTO does not have at its disposal the tools or facilities deemed necessary to make physical determinations of the sort and an otherwise old composition is still not patentable regardless of any new or unexpected

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properties. In re Fitzgerald et al, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112 - § 2112.02.

Even if assuming that the prior art references do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive composition because the disclosure of the inventive subject matter appears within the generic disclosure of the prior art. Contrary to applicant's assertions, the water-based ink compositions are not completely different from applicant's water-based ink composition.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (703) 306-5701. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.



KCE

January 15, 2003